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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,543	02/17/2000	ERIC RADIGON	ATOCM-151	5260

7590

05/03/2002

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EXAMINER

SZEKELY, PETER A

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/03/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/34,543

Applicant(s)

Redigan et al.

Examiner

Szekely

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on 9/12/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

1. The final rejection imposed in Paper #13 is withdrawn by the Examiner. Prosecution of the instant application is hereby reopened.

Specification

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

3. The attempt to incorporate subject matter into this application by reference to Ullmann's Encyclopedia of Industrial Chemistry is improper because it is a publication. See page 9, lines 15-18.

4. The disclosure is objected to because of the following informalities: On page 2, line 23, ethylene/alkyl meth(acrylate) is mentioned. Ethylene/alkyl (meth)acrylate maybe?.

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of a non-reactive HMPSA. This is a negative limitation, requiring explicit antecedent basis in the specification. See *Ex parte Grasselli*, 231 USPQ 393-394, (1986). The limitation in claims 11 and 15, that the MFI has to be at least 200mg/10 min. is not in the description either. 200g/10 min. maybe?

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6, 16, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. The word derivative renders these claims indefinite. CO₂ is a derivative of both rosin and terpene. It is derived by burning. See *Austen Laboratories, Incorporated v. Nobile*

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Processing Company of Chicago et al. (DC NILL) 115 USPQ 44 (1957) and Petrolite Corporation v. Watson, Comr. Pats. (DC DC) 113 USPQ 248 (1957). Both of these decisions are enclosed. In claims 17 and 20, both “rosin” and “rosin derivatives” are misspelled as “resin” and “resin derivatives” respectively, and claim 20 improperly depends from claim 17.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
11. Claims 1-23 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ATO Findley S.A. WO 97/12007.
12. ATO Findley discloses an ethylene-alkyl acrylate copolymer, tackifying resin and thinning agent (that is, plasticizer) in claim 1. The alkyl acrylate can be 2-ethylhexyl acrylate (claim 3). The MFI is between 0.5 and 1000g/10 min. (Claim 4). The tackifier is 30-80% of the composition, the plasticizer content is up to 35% of the composition (claim 6). The acrylate content of the copolymer is 15-45% (page 6, lines 1-2), and mixtures of copolymers is discussed on page 6, lines 9-12. The coating temperature is 180°C (Examples) The tackifiers cited are identical to those claimed by applicants, thus the softening point are the same. Applicants' claims are not novel. In the alternative, the softening point range is so broad, that most commercially used tackifiers would satisfy the requirement, making the limitation obvious to one having ordinary skill in the art, at the time the invention was made.

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13. Claims 1-4, 6, 7 and 9-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uchigaki et al. 3,931,077

14. Uchigaki et al. teach tackifiers, with their concentrations and liquid temperatures, and thermoplastic resin in claim 1 and ethylene-2-ethylhexyl acrylate in column 5, lines 18-19.

Ethylene content of the copolymer is shown in claim 4. The "non-reactive" limitation is new matter. The presence of the reactive component does not interfere with the invention.

Applicants' claims are not novel. In the alternative, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to raise the coating temperature to 140°C, if the viscosity was too high at lower temperatures.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on Tuesday through Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718 or (703) 305-5408.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Peter Szekely', with a stylized, cursive script.

Peter Szekely

Primary Examiner

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